

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephens)
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For: Location-Based Mobile Service)
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 Provision)
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Serial No.: 10/539,849)
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Filed: December 5, 2003)
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371(c) Date: June 20, 2005)
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Examiner: Karikari, K.)
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Art Unit: 2617)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Attention: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF

This reply brief is in furtherance of the Examiner's Answer, mailed on April 10, 2008. The reply brief includes the appellant's response to the Examiner's most recent issues raised in the previously noted Examiner's Answer, which includes a Response to Argument section, beginning at the bottom of page 13 of the Examiner's Answer.

In responding to appellant's arguments relative to the Examiner's rejection, based upon 35 USC §112, first paragraph, the Examiner acknowledges that roaming is part of the present application, as originally filed. However, the Examiner continues to appear to look for the exact phrasing, in so far as the Examiner appears to look for a linkage between the term "roaming" and the phrase "traveling to a previously undisclosed location where a service is to be performed", as the Examiner finds fault in absence of an express definition in the application linking the two.

However, such an express definition being present in the application is unnecessary where the concept corresponds to the normal understanding of the term. A definition for the term “roaming” from a dictionary, the American Heritage Dictionary of the English Language, was provided. It is worth noting that the Examiner neither objected to the definition, nor did the Examiner propose an alternative definition. Consequently, the dictionary definition is presumed to have been accepted as a reasonable definition for roaming. The question then becomes one of is the claim language a fair characterization of the concept embodied by the term roaming in the context used given the term’s association with a service provider in the specification.

The dictionary definition equated the term roaming with a meaning of “as moving about without purpose or plan”, which would appear to be opposite to the concept of a scheduled route (i.e. a bus), or a preplanned pick up time at a designated location (i.e. calling a taxi), where the user of the service knows of the pre-planned availability of a service relative to a particular location (i.e. a bus route), or initiates the service request relative to a particular location (i.e. calling a taxi). In such instances, the bus and/or the taxi could hardly be said to be roaming. The Examiner has made no attempt to explain why the concept of “moving about without purpose or plan” does not teach or suggest the claimed traveling to a previously undisclosed location. Instead, the Examiner focuses on whether the term “roaming” is expressly linked to the exact phrase used in the claim. However, we know from the Federal Circuit that there is no requirement that the exact phrase be found in the specification, a proposal of the applicable standard of review, that is not refuted by the Examiner. Consequently, it is not clear why the Examiner continues to require the presence of exact phrasing, or why the Examiner continues to rely of the lack of the exact phrasing as the basis for the rejection. Alternatively, the focus should be upon whether the claim language is a fair characterization of the concept of roaming, which has been linked with the concept of the service provider in the present application, in connection with one or more exemplary embodiments envisioned at the time of filing the present application.

The Examiner does make reference to some of the teachings from the specification, which were referenced from the specification. In doing so, the Examiner contests whether the phrasing supports the objected to phrasing. More specifically, the Examiner references page 12,

lines 30-34, which was noted by the applicant, which states “when the service provider is in, or has indicated a subsequent visit to a cell area”, and questions whether the cited section supports the objected to phrase. It is only when viewed in context, that one can appreciate its relevance. The particular phrase identifies that the identification of the available service is broadcast to a cell area, when the service provider is in, or has indicated a subsequent visit to a cell area. In other words, the availability of the service provider relative to a particular area was otherwise previously unannounced. The newly determined availability of a service provider in a particular area is matched with the previously identified location of the users having an interest in a particular service. Hence, the fair characterization that the service provider is traveling to a previously undisclosed location, as the announcement is made when the service provider is entering or is about to enter an area, and that the movement is a result of circumstance and not a regular pre-scheduled route.

In view of the term roaming, and the other identified passages, support for the phrase “previously undisclosed location” relative to a description of the motion of the service provider, is supported as being in the possession of the inventor at the time of filing, such that a corresponding amendment to the claims incorporating such a phrase at a later date are fully supported by the original disclosure materials. As such, the Examiner’s objection of the claims based upon 35 USC §112, first paragraph, should be overturned.

With respect to the Examiner’s comments concerning the Appellant’s arguments as to whether the claims are anticipated by Haddad, US Published Patent Application No. 2003/0137435, the Examiner largely reiterates his prior remarks. As such, Appellant’s prior analysis of each of the cited sections continues to be relevant, where when the phrases from the reference are viewed in their full context, it becomes clear that the updated status applies to an expected event, such as the type associated with a regularly scheduled route, or a pre-planned pick up time. One needs only look at the summary of the invention beginning at paragraph 0009 to fully appreciate the context of the teachings of the cited reference. The phrase “expected” occurrence is an often repeated concept.

Further with respect to the diversion of one bus from a less busy route to a busy route, the Examiner is ignoring the fact that the particular service to be performed is still an expected event

relative to the particular location, regardless as to which particular bus performs the service. Consequently a shuffling of busses between routes does not avoid the fact that the reference is teaching a status update relative to an expected event (i.e. service) relative to a particular location, and thus fails to make known or obvious, the provision of the availability of a service relative to a location in the context of a service provider traveling to a previously undisclosed location where a service is to be performed. As the events in the reference are tied to expected events, the actions of the service providers in Haddad et al., ‘435, does not fit with either the concept of roaming, as defined above, or the related “traveling to a previously undisclosed location”. In Haddad, ‘435, absent an expected event, there can be no expectation against which a status can be provided, or any knowledge that a status exists relative to a service provider that might be of interest. Alternatively, in the present application, there is knowledge of an interest in services by parties associated with a particular area, such that when a corresponding service provider enters or is about to enter an area, the availability of the service provider relative to a particular area can be matched with the previously known interest in such services. However, contrary to the relied upon reference, Haddad, ‘435, in the present application the interest in the service is known without there being any knowledge of any particular expected occurrence of when a service provider might be available relative to their location.

Because Haddad, ‘435, does not teach roaming and involves an expected event or occurrence, the combination of Haddad, ‘435, and Kinnunen et al., US Published Patent Application 2001/0018349, fails to account for the above noted deficiencies. Interestingly, the Examiner does not dispute that Kinnunen et al., ‘349, fails to teach or suggest the traveling of a service provider to a previously undisclosed location, only an indication that Haddad, ‘435, and not Kinnunen et al., ‘349, is relied upon in making known or obvious that particular feature. Therefore to the extent that Haddad, ‘435, does not make known or obvious “a service provider traveling to a previously undisclosed location, Kinnunen et al., ‘349, fails to account for any such deficiency.

In view of the above noted reasoning, the applicants would respectfully request that the Examiner's decision to finally reject pending claims 32 to 55 be overturned.

Respectfully submitted,

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